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09/475,112	12/30/1999	JON N. LEONARD	BEU/LEONARD2	5971

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EXAMINER

MUHEBBULLAH, SAJEDA

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/475,112

Applicant(s)

LEONARD ET AL.

Examiner

Sajeda Muhebbullah

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-23, and 25-30 is/are rejected.
- 7) ☒ Claim(s) 21 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 01/31/2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant failed to include a copy of the publication cited in the IDS filed on 01/31/2001.

### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 22-29 have been renumbered 23-30 respectively.

Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18, 23-24, and 26-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites the limitation "the

clock" in line 3. There is insufficient antecedent basis for this limitation in the claim. Claims 23-24 recite the limitation "message as claim in claim 21" in line 1. Claims 26-30 recite the limitation "A method as claimed in claim 24" in line 1.

It appears claims 23-24 should depend on claim 22 and claims 26-30 should depend on claim 25.

The examiner will interpret claims 23-24 and 26-30 according to the suggested changes. However, appropriate corrections are required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Henderson et al. ("Henderson", US 6,185,603).

As per independent claim 11, Henderson teaches an electronic mail system, comprising:

a first computer on which is installed message origination software and which is connected to a network capable of carrying an electronic mail message and at least one recipient computer also connected to said network (col.2, lines 56-66; col.3, line 1); and

a viewer applet installed on said recipient computer (col.4, lines 53-55; col. 5, line 1),

said viewer applet being arranged to control a manner in which an information in an electronic mail wrapper associated with the electronic mail message is presented to a recipient of the message, said control including selection of information to present and control of coupling of the information and the message (col.4, lines 63-66).

As per claim 12, Henderson teaches the electronic mail system of claim 11, further comprising a central electronic mail server connected to said network, said electronic mail server being arranged to cooperate with said viewer applet to achieve said control of the manner in which the electronic mail wrapper is presented to the recipient (col.4, lines 58-65).

7. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Ogilvie et al. ("Ogilvie", US 6,324,569).

As per claim 14, Ogilvie teaches a method of controlling an electronic mail message transmitted over a network, comprising the steps of:

after transmission of the electronic mail message over the network, identifying and selecting information in a message wrapper (col.5, lines 28-32); and

encrypting said electronic mail message so that only said selected information can be viewed with the message using a viewer applet installed on a recipient computer (col.5, lines 52-54; col.16, lines 8-13).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorne et al. ("Thorne", US 5,958,005) in view of Netscape 2 Simplified ("Netscape").

As per independent claim 1, Thorne teaches an electronic mail control software comprising:

means for opening a window arranged to enable a user of the electronic mail applications program to select control options to be applied to an electronic mail message created using the electronic mail applications program (col.6, lines 45-48). Although it is inherent that a recipient's address must be entered to direct the email to its destination and Thorne teaches the delivery of the message via a server, Thorne does not disclose a means for modifying an address to which the message it to be sent in order to direct the message to a central mail server. Netscape teaches an email system that includes a means for modifying an address of the mail server to which the messages are to be sent (pg.112, step 9). It would have been obvious to an artisan at the time of the invention to include Netscape's method with Thorne's email system in order to direct the message to a central mail server arranged to implement the control options.

As per claim 2, Thorne teaches the electronic mail control software of claim 1, wherein said control options include an expiration setting by which the user may select a date, time, or event, the occurrence of which will cause said message to expire (col.6, line 61).

As per claim 3, Thorne teaches the electronic mail control software of claim 1, wherein said control options include limitations on forwarding by a recipient of said message (col. 6, line 54).

As per claim 4, Thorne teaches a means for opening a window in response to interception of a command (col.7, lines 9-11). However, Thorne's command is a compose command rather than a send command. Although Thorne intercepts a command other than the send command, in effect both achieve the same results of opening a window prior to transmission of the message. It would have been obvious to an artisan at the time of the invention to modify Thorne's teaching to open a window in response to interception of any command, in this case it could be the send command, as long as it is prior to transmission of the message.

As per claim 5, Thorne teaches the delivery of messages via a server. However, Thorne fails to teach a means for modifying at least one entry in an address book. Netscape teaches a means for modifying an entry in an address book (pg. 122-123, step 4-5). It would have been obvious to an artisan at the time of the invention to include Netscape's method with Thorne's email system in order to store the email addresses used frequently and saving time from having to type the address over.

Claims 6-10 are similar in scope to claims 1-5 respectively, and are therefore rejected under similar rationale.

10. Claims 13, 15, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson et al. ("Henderson", US 6,185,603) in view of Ogilvie et al. ("Ogilvie", US 6,324,569).

As per claim 13, although Henderson teaches a central mail server cooperating with a viewer applet arranged to display the email message with information deleted from the wrapper, Henderson fails to teach the mail server to encrypt the message and sending it to the viewer applet to decrypt the message for viewing. Ogilvie teaches an email system providing the originator control over the message where the message is encrypted and requires a key from the recipient to decrypt the message for viewing through the viewer applet (col. 9, lines 33-43; col. 16, lines 8-13). It would have been obvious to an artisan at the time of the invention to combine Ogilvie's teaching with Henderson's email system in order to provide security to messages sent over a network where only the intended recipient can view the message.

As per claim 15, Henderson teaches a method of controlling an electronic mail message transmitted over a network, comprising the steps of:

before transmission of the electronic mail message over the network, attaching limitations on processing and handling of the electronic mail message by a recipient (col.3, lines 61-63);

initially transmitting said electronic mail message over said network to a central electronic mail server (col.4, lines 44-45);

storing said electronic mail message at said electronic mail server (col.2, lines 57-58);



Henderson teaches a central mail server cooperating with a viewer applet on the recipient computer arranged to display the email message with information deleted from the wrapper. However, Henderson fails to teach the mail server to encrypt the message, store the message on the recipient computer, sending it to the viewer applet to decrypt the message using a session key, and causing the server and applet to implement the processing and handling limitations. Ogilvie teaches an email system providing the originator control over the message where the message is encrypted and requires a key from the recipient to decrypt the message for viewing through the viewer applet (col. 9, lines 33-43; col. 16, lines 8-13). It would have been obvious to an artisan at the time of the invention to combine Ogilvie's teaching with Henderson's email system in order to provide security to messages sent over a network where only the intended recipient can view the message.

Claim 19 is similar in scope to the combination of claims 13 and 15, and is therefore rejected under similar rationale.

Claim 22 is similar in scope to claim 15, and is therefore rejected under similar rationale.

11. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson et al. ("Henderson", US 6,185,603) and Ogilvie et al. ("Ogilvie", US 6,324,569) as applied to claim 15 above, and further in view of Whitehouse (US 6,005,945).

As per claim 16, the method of Henderson and Ogilvie teaches the use of a key to decrypt the message for displaying. However, Henderson and Ogilvie fail to teach the session key to be supplied by the server each time the message is to be viewed.

Whitehouse teaches a method of encrypting data messages whereby a session key is provided by a central server each viewing transaction (col.9, lines 16-21, lines 64-66). It would have been obvious to an artisan at the time of the invention to include Whitehouse's teaching with the method of Henderson and Ogilvie in order to prevent the risk of tampering of the session key and provide security to messages sent over a network where only the intended recipient can view the message.

As per claim 17, the method of Henderson and Ogilvie teaches the use of a key to decrypt the message for displaying. However, Henderson and Ogilvie fail to teach the session key to be renewed periodically in order to view the message. Whitehouse teaches a method of encrypting data messages whereby a session key is periodically renewed by a central server (col.9, lines 40-42; col.12, lines 53-56). It would have been obvious to an artisan at the time of the invention to include Whitehouse's teaching with the method of Henderson and Ogilvie in order to prevent the risk of tampering of the session key and provide security to messages sent over a network where only the intended recipient can view the message.

Claim 18 is similar in scope to claim 17, and is therefore rejected under similar rationale.

12. Claims 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson et al. ("Henderson", US 6,185,603) and Ogilvie et al. ("Ogilvie", US 6,324,569) as applied to claim 19 above, and further in view of Smith et al. ("Smith", US 6,061,448).

As per claim 20, the method of Henderson and Ogilvie teaches the use of a key to decrypt the message for displaying. However, Henderson and Ogilvie fail to teach the

message to be encrypted by the server using a public key generated by the viewer applet and decrypting the message using an associated private key. Smith teaches a method for secure document delivery whereby a server encrypts a message using a public key generated by an applet and the corresponding private key generated by the applet is used by the recipient to decrypt the message (col.5, lines 11-13, lines 61-66; col.6, lines 1-4). It would have been obvious to an artisan at the time of the invention to include Smith's teaching with the method of Henderson and Ogilvie in order to provide security to messages sent over a network where only the intended recipient can view the message.

Claim 23 is similar in scope to claim 20, and is therefore rejected under similar rationale.

13. Claims 25 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US 5,864,684) in view of Sidhu et al. ("Sidhu", US 5,734,901) and Druckenmiller et al. ("Druckenmiller", US 6,167,435).

As per claim 25, Nielsen teaches a mailing list comprising the step of sending an electronic mail message to an initial list of recipients and requiring that forwarded version of said electronic mail message be routed through at least one central mail server (col.2, lines 10-15). Nielsen fails to teach tracking all transactions involving said electronic mail message and using a record of at least a portion of said transactions to expand said electronic mailing lists. Sidhu teaches a method of e-mail whereby previous transactions are tracked within the email application (col.9, lines 34-60). It would have been obvious to an artisan at the time of the invention to include Sidhu's teaching with Nielsen's mailing list in order to view the history of the message to gather possible recipients interested in similar messages. Although the method of Nielsen and Sidhu

teaches the tracking of email transactions, the method of Nielsen and Sidhu fails to teach the step of using a record of at least a portion of said transactions to expand said electronic mailing list. Druckenmiller teaches a method of generating electronic mailing lists whereby a record of possible recipients to add to the list is used to expand the mailing list (col.3, lines 23-26, lines 64-66). It would have been obvious to an artisan at the time of the invention to include Druckenmiller's teaching with the method of Nielsen and Sidhu in order to further expand the mailing list to interested individuals.

As per claim 28, Sidhu teaches a record of all address to which the message has been forwarded (col.9, lines 55-57).

Claim 29 is similar in scope to claim 28, and is therefore rejected under similar rationale.

As per claim 30, in addition to all claim limitations as applied to claim 25, Druckenmiller further teaches selling of a mailing list (col.1, lines 14-15).

14. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US 5,864,684), Sidhu et al. ("Sidhu", US 5,734,901) and Druckenmiller et al. ("Druckenmiller", US 6,167,435) as applied to claim 25 above, and further in view of Henderson et al. ("Henderson", US 6,185,603) and Ogilvie et al. ("Ogilvie", US 6,324,569).

As per claim 26-27, although the method of Nielsen, Sidhu, and Druckenmiller teaches the transmission of an electronic message, the method of Nielsen, Sidhu, and Druckenmiller fails to teach the attachment of handling limitations that will cause the message to expire and encryption of the message to be viewed by a viewer applet before the set expiration date. Henderson teaches the step of before transmission of the

message, attaching handling limitations such as when the message will expire (col.7, lines 26-29). It would have been obvious to an artisan at the time of the invention to combine Henderson's teaching with the method of Nielsen, Sidhu, and Druckenmiller in order to provide convenience to the user from having to delete previous emails. Although the method of Nielsen, Sidhu, Druckenmiller, and Henderson teaches the viewing of an email prior to expiring, the method of Nielsen, Sidhu, Druckenmiller, and Henderson fails to teach the encryption of the message to be viewed by a viewer applet before the set expiration date. Ogilvie teaches encrypting the message to be viewed by a viewer applet supplied by the central server (col. 9, lines 33-43; col. 16, lines 8-13). It would have been obvious to an artisan at the time of the invention to combine Ogilvie's teaching with the method of Nielsen, Sidhu, Druckenmiller, and Henderson in order to provide security to messages sent over a network where only the intended recipient can view the message.

***Allowable Subject Matter***

15. Claims 21 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

The prior art made of record fails to anticipate or make obvious the claimed invention.

Although the method of Henderson and Ogilvie teaches the viewer applet to be arranged to permit a user to request forwarding of said electronic mail message to a recipient computer, said central mail server being arranged to strip and store information

concerning said message, a copy of the viewer applet installed on said recipient computer being arranged to store said stripped message, the method of Henderson and Ogilvie fails to teach the method wherein the viewer applet is arranged to perform various steps in conjunction with a second recipient computer as recited in claims 21 and 24.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **Inquiries**

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajeda Muhebbullah whose telephone number is (703) 305-3989. The examiner can normally be reached on Monday - Friday from 7:00 am to 4:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax number for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238 [After Final Communication]

(703) 746-7239 [Official Communication]

(703) 746-7240 [For status inquiries, Draft Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Sajeda Muhebbullah  
Patent Examiner  
April 29, 2002

*Kristine Kincaid*  
**KRISTINE KINCAID**  
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